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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,724	10/23/2003	Lawrence R. Miller	10003-0067	2387

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JONES DAY
222 EAST 41ST ST
NEW YORK, NY 10017

EXAMINER

POND, ROBERT M

ART UNIT PAPER NUMBER

3625

DATE MAILED: 12/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/693,724

Applicant(s)

MILLER ET AL.

Examiner

Robert M. Pond

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Pending Claim 1 was examined in this non-final Office Action.

Response to Arguments

Pertaining to Remarks (page 3, second paragraph)

Applicant's arguments, see Remarks (page 3, second paragraph) filed 13 September 2004, with respect to the rejection of Claim 1 under 35 USC 103(a) have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a new ground(s) of rejection is made in view of Asay under 35 USC 102(b). For the reasons noted below, the Examiner maintains the use of Asay based on new grounds of rejection no longer relying upon well within the skill.

Rejection under 35 USC 103(a)

Applicant's arguments filed 13 September 2004 have been fully considered but they are not persuasive. The Applicant argues the following:

- **Four-corner model:** The Applicant argues in the context of a four-corner model a method claim that lacks any structural specificity of a four-corner model. The Applicant's arguments rely upon assertions that merely summarize benefits of the four-corner model and thereby provide minimal basis for argument.

- Does not teach or disclose i) the warranty comprising a contract between the entity and the subscriber, ii) receiving a request for a warranty from the subscriber to whom the entity issued a digital certificate, and iii) receiving a validation request from the relying party.

The Applicant is merely making a statement of what the prior art does not teach and supports the statement with arguments based on the four-corner model as noted above. However, for the Applicant's convenience, the Examiner is specifically pointing to disclosures relied upon in Asay.

i. Assigning a warranty cap to an entity that issues digital certificates:

Certificate authority is notified about transactions that would cause its cumulative liability to exceed some value (please note examiner's interpretation: "some value" is a cap that was previously assigned a value) (see at least col. 33, lines 29-31).

ii. Tracking a warranty volume for the entity:

Reliance manager tracks the cumulative liability of each certification authority (see at least Fig. 6 (206, 218, 220); col. 33, lines 20-21).

iii. Receiving a request for a warranty from a subscriber-warranted

amount and claim period: certificate authority issues a digital certificate to a subscriber, the certificate having a reliance limit and claim period (see at least col. 33, lines 57-67; col. 35, lines 25-37).

iv. Evaluating the request for a warranty; not to exceed cap:

Evaluates risk, bounds risk, thresholds (see at least col. 4, lines 43-

48); certificate authority is notified about transactions that would cause its cumulative liability to exceed some value (please note examiner's interpretation: evaluation is based on cap being exceeded which triggers notification) (see at least col. 33, lines 29-31).

- v. Transmitting a message that confirms issuance of the requested warranty; message digitally signed; warranty comprising contract between the entity and subscriber; relying party being a third-party beneficiary: confirming issuance of the requested warranty (see at least col. 42, lines 27-57); most legal systems treat a certificate as a representation pursuant to a contract between the issuing certificate authority and the subscriber; persons other than the subscriber may rely on the certificate (e.g. relying party); treating the relying party as a third-party beneficiary of the contract between the subscriber and certificate authority (see at least col. 2, lines 21-33); messages are digitally signed (see at least col. 1, lines ; col. 32, lines 27-37; col. 34, lines 33-51; col. 41, lines 10-41).
- vi. Receiving a validation request from the relying party: relying party sends a validation request (see at least Fig. 6 (212, 216); col. 32, lines 29-32; col. 41, lines 42-57).

- vii. Transmitting a validation response to the relying party: sends validation to relying party (see at least Fig. 6 (212, 226); col. 44, line 62 through col. 45, line 43; col. 46, lines 4-).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. **Claim 1 is rejected under 35 USC 102(b) as being anticipated by Asay et al. (Paper #2, patent number 5,903,882 hereinafter referred to as “Asay”).**

Asay teaches all the limitations of Claim 1. For example, Asay discloses a method of managing reliance in an electronic transaction system (see at least abstract; Fig. 1 (100); Fig. 6 (200); col. 4, line 20 through col. 9, line 45). Asay further discloses:

- Assigning a warranty cap to an entity that issues digital certificates:

Certificate authority is notified about transactions that would cause its cumulative liability to exceed some value (please note examiner's interpretation: “some value” is a cap that was previously assigned a value) (see at least col. 33, lines 29-31).

- Tracking a warranty volume for the entity:

- Reliance manager tracks the cumulative liability of each certification authority (see at least Fig. 6 (206, 218, 220); col. 33, lines 20-21).
- Receiving a request for a warranty from a subscriber-warranted amount and claim period: certificate authority issues a digital certificate to a subscriber, the certificate having a reliance limit and claim period (see at least col. 33, lines 57-67; col. 35, lines 25-37).
 - Evaluating the request for a warranty; not to exceed cap: evaluates risk, bounds risk, thresholds (see at least col. 4, lines 43-48); certificate authority is notified about transactions that would cause its cumulative liability to exceed some value (please note examiner's interpretation: evaluation is based on cap being exceeded which triggers notification) (see at least col. 33, lines 29-31).
 - Transmitting a message that confirms issuance of the requested warranty; message digitally signed; warranty comprising contract between the entity and subscriber; relying party being a third-party beneficiary: confirming issuance of the requested warranty (see at least col. 42, lines 27-57); most legal systems treat a certificate as a representation pursuant to a contract between the issuing certificate authority and the subscriber; persons other than the subscriber may rely on the certificate (e.g. relying party); treating the relying party as a third-party beneficiary of the contract between the subscriber and certificate authority (see at least col. 2, lines 21-33); messages are digitally signed (see at least col. 1, lines ; col. 32,

lines 27-37; col. 34, lines 33-51; col. 41, lines 10-41).

- Receiving a validation request from the relying party: relying party sends a validation request (see at least Fig. 6 (212, 216); col. 32, lines 29-32; col. 41, lines 42-57).
- Transmitting a validation response to the relying party: sends validation to relying party (see at least Fig. 6 (212, 226); col. 44, line 62 through col. 45, line 43; col. 46, lines 4-).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- US 5,557,518 (Rosen) 17 September 1996; teaches a four-corner model of conducting trusted electronic commerce transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mr. Robert M. Pond** whose telephone number is 703-605-4253. The examiner can normally be reached Monday-Friday, 8:30AM-5:30PM Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Ms. Wynn Coggins** can be reached on 703-308-1344.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **703-308-1113**.

Any response to this action should be mailed to:

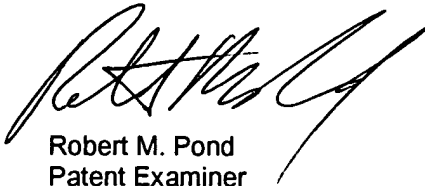
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or faxed to:

703-872-9306 (Official communications; including After Final communications labeled "Box AF")

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal
Drive, Arlington, VA, 7th floor receptionist.

A handwritten signature in black ink, appearing to read 'R. M. Pond', written in a cursive style.

Robert M. Pond
Patent Examiner
December 7, 2004